REMARKS

Applicant respectfully requests reconsideration. Claims 39-41 were previously pending in this application. By this amendment, claim 39 is currently amended. No new claims have been added, and no claims have been canceled. As a result, claims 39-41 remain pending for examination, with claim 39 being an independent claim. No new matter has been added.

The preamble of claim 39 is currently amended to specify that the kit is for treating inflammation, autoimmunity, transplant rejection, an allergic condition, or a T cell cancer by inducing apoptosis of activated T cells. Basis for this amendment can be found, for example, in original claim 39 and the paragraph bridging pages 8-9 of the specification.

Rejections Under 35 U.S.C. §103

The Examiner maintained his rejection of claims 39-41 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0002450 to Lazarovits et al. ("Lazarovits et al.") and/or U.S. Patent Application Publication No. 2004/0001839 to Levanon et al. ("Levanon et al. 2004"), in view of U.S. Patent No. 6,348,581 to Anderson et al. ("Anderson et al.") and/or U.S. Patent No. 6,884,619 to Hockfield et al. ("Hockfield et al."), and further in view of the Lin 132 Declaration filed 02/01/2007 in priority application USSN 10/051,497, Example 10 of the instant specification, and US 2005/0152906 by Levanon et al. More particularly, on page 3 of the Office Action the Examiner asserted that Applicant appears to be "arguing product-by-process limitations" with respect to the claimed products, and that if the claimed product "is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 227 USPQ 964, 966 (Fed. Cir. 1985).

On pages 4 and 5 of the Office Action, the Examiner conceded that neither Lazarovits et al. nor Levanon et al. 2004 teaches kits as claimed.

For the avoidance of any possible doubt, Applicant does not accede to any possible intimation by the Examiner that claim 39 is a product-by-process claim.

As Applicant pointed out in its response filed March 5, 2009, an invention that would have been obvious to a person of ordinary skill at the time of the invention is not patentable under 35 U.S.C. §103(a). Indeed, the relevant part of the statute specifically says

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

A plain reading of the statute makes clear that it does *not* apply if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would *not* have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Claim 39 would *not* have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Neither Lazarovits et al. nor Levanon et al. 2004 discloses any recognition that any anti-PSGL-1 antibody, including KPL1, is capable of inducing apoptosis of activated T cells. The inventors of the present invention made the unexpected discovery that certain anti-PSGL-1 antibodies, but not all anti-PSGL-1 antibodies, are in fact capable of inducing apoptosis of activated T cells. Prior to this discovery, persons skilled in the art believed that anti-PSGL-1 antibodies exerted their effects only by interfering with the interaction between PSGL-1 and its ligands such as P-selectin. Accordingly, at the time the present invention was made, persons skilled in the art would not have thought to select an anti-PSGL-1 antibody based on its ability to bind specifically to PSGL-1 on the surface of an activated T cell and to induce apoptosis of the activated T cell.

In respect of the rejected claims, the fact that an antibody in the prior art such as KPL1 inherently possesses the ability to bind specifically to PSGL-1 on the surface of an activated T cell and to induce apoptosis of the activated T cell goes to the question of anticipation, not to the question of obviousness. The Examiner has already acknowledged that the claims are not anticipated by the art of record. As noted above, persons skilled in the art at the time the present

invention was made had no appreciation that only certain anti-PSGL-1 antibodies can bind specifically to PSGL-1 on the surface of an activated T cell and induce apoptosis of the activated T cell. Accordingly, Applicant respectfully submits that the Lin 132 Declaration filed 02/01/2007 in priority application USSN 10/051,497, Example 10 of the instant specification, and the post-filing reference US 2005/0152906 by Levanon et al. (claiming priority to June 30, 2003), cited by the Examiner as evidence of an intrinsic property of certain prior art anti-PSGL-1 antibodies, are irrelevant to the question of obviousness of the rejected claims.

In fact, US 2005/0152906 makes no disclosure in respect of any antibody inducing apoptosis of activated T cells. This reference principally concerns only Y1-IgG. The disclosure of this reference as a whole, including in particular the passages cited by the Examiner, is silent about any ability of this antibody to bind specifically to PSGL-1 on the surface of an activated T cell and induce apoptosis of the activated T cell. Rather, the examples section is concerned with Y1-IgG-mediated antibody-dependent cellular cytotoxicity (ADCC) and complement-dependent cytotoxicity (CDC) directed toward malignant B cells (B-CLL) and acute myeloid leukemia cells (AML; ML2), and Y1-IgG-associated apoptosis of malignant B cells (B-CLL). See paragraphs [0188] to [0200] and [0206] to [0209]. Neither B-CLL cells nor AML cells are activated T cells. These passages thus make no teaching or suggestion in connection with any antibody inducing apoptosis of activated T cells.

As has previously been argued by Applicant, neither Anderson et al. nor Hockfield et al. provides what is lacking from Lazarovits et al. or Levanon et al. 2004. The cited references, even if combined as suggested by the Examiner, fail to teach or suggest, i.e., do not account for, all the recited features of the claimed invention.

Taken together, it is evident that the claimed product is neither the same as nor obvious from a product of the prior art. In re Thorpe, 227 USPQ 964, 966 (Fed. Cir. 1985). Moreover, it is evident that the claimed invention would *not* have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Accordingly, withdrawal of the rejection of claims 39-41 under 35 U.S.C. §103(a) is respectfully requested.

CONCLUSION

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, the Director is hereby authorized to charge any deficiency or credit any overpayment in the fees filed, asserted to be filed or which should have been filed herewith to our Deposit Account No. 23/2825, under Docket No. .

Dated: August 18, 2009

Respectfully submitted,

By _____

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